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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,589	07/08/2003	Joe S. Wilkins JR.	WRC/8c	8939

7590 08/23/2006  
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Estero, FL 33928-0215

EXAMINER

ROBERTS, LEZAH

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,589	<b>Applicant(s)</b> WILKINS, JOE S.	
	<b>Examiner</b> Lezah W. Roberts	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on June 8, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08 Jun 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office Action is in response to the Amendment filed June 8, 2006. All rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claims*

#### **Claim Rejections - 35 USC § 102 – Anticipation**

1) Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Greathouse et al. (US 3,023,144). The rejection is maintained.

Applicant argues the reference teaches that d-limonene per se has been found to possess comparatively little germicidal activity. Applicant further argues, Greathouse et al. teaches that limonene is not an anti-bacterial compound. Therefore, it does not teach a method of killing or inhibiting the growth of bacteria externally on the skin or within the nasal cavity of an animal using d-limonene. Applicant has amended the claims to clarify that the formulation comprising “a therapeutically effective amount of d-limonene is applied to the skin or nasal cavity for a time sufficient for said d-limonene to effectively eradicate or inhibit the growth of said bacteria”. The argument is not persuasive.

Greathouse et al. teaches d-limonene has low activity but does not state it has no activity. The reference also teaches it act as a solvent and penetrant and when used in

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combination with its derivatives, surprisingly brings about an enhanced or synergistic fungicidal and bactericidal action (col. 2, lines 38-44). Therefore, it is concluded d-limonene does possess some anti-bacterial activity. It is also concluded the d-limonene effectively inhibit the growth of bacteria because it provides an enhanced or synergistic fungicidal and bactericidal action. Synergistic means the two compounds work together and the total effect is greater than the sum of the individual effects (Merriam-Webster's online Dictionary, 2006). The d-limonene played an active part in the fungicidal and bactericidal action, therefore encompassing the amended claims.

2) Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin (US 20030180349). The rejection is maintained.

Applicant argues that the Franklin reference is not enabling disclosure for the teaching that limonene is effective for killing or inhibiting the growth of bacteria externally on the skin or internally with in the nasal cavity of an animal. Applicant also argues limonene is merely mentioned in a laundry list of terpenes deemed to work in the invention. Also the reference does not disclose limonene being used in an example or in the claims. This argument is not persuasive.

Franklin teaches compositions comprising a single terpene, a terpene mixture, or a liposome-terpene(s) for prevention and treatment of a respiratory infection. Although limonene is not disclosed in an example, it is disclosed as an effective terpene that may be used in the composition (paragraph 0127). In response to "there is no discussion with respect to how limonene is formulated or applied", one skilled in the art would know

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how to optimize the amount of limonene in order to incorporate it into the compositions by the examples and general procedure disclosed in the reference. The claims of the reference, particularly claim 9, also recites the use of limonene in the compositions.

Furthermore, although limonene is included in a list of species, the reference is nevertheless anticipatory because it specifically names the particular species recited therein. See MPEP 2131.02, which states:

A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). *Id.* at 1718. See also *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and because the claim was anticipated, the unexpected properties were immaterial.).

### **Claim Rejections - 35 USC § 103 – Obviousness**

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greathouse et al. in view of Wolff. The rejection is maintained.

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Applicant argues claims 2 and 4 are dependent on claim 1 and the reasons are discussed above.

The rejection is maintained in regards to claim 1 therefore the rejection is maintained in regards to claims 2 and 4.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claims 1-5 are rejected.

Claims 6-17 are withdrawn.

No claims allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lezah Roberts  
Patent Examiner  
Art Unit 1614



Frederick Krass  
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